

**REMARKS**

**I. INTRODUCTION**

As a result of the amendments set forth above, claims 1-24 are presently pending in this application. Claims 1-7 presently stand rejected, claims 8-20 have been allowed, and claims 21-24 have been added. In light of the arguments that appear below, Applicants respectfully request reconsideration of their application.

**II. AMENDMENTS TO THE CLAIMS**

Claims 21-24 have been added to the present application. Applicants respectfully submit that support for these claims can be found throughout the Specification, Claims and Drawings, as originally filed. Accordingly, Applicants respectfully submit that no new matter has been added as a result of the addition of these claims.

**III. REJECTION OF CLAIMS 1-4, 6 AND 7 UNDER 35 U.S.C. § 103(a)**

Claims 1-4, 6 and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,572,640 issued to Lovegrove in view of U.S. Patent No. 5,387,068 issued to Pearson.

More particularly, the Office asserts that Lovegrove shows an air-powered vacuum tool comprising a plurality of vacuum ports (14) formed in a body (12) and a plurality of pickup orifices (18) operatively connected to certain ports. The Office further asserts that Lovegrove uses a manual dial valve (38) to selectively provide vacuum to the desired ports (14), rather than using a dedicated generator for each port as is called for in the claims of Applicants' application. However, the Office still further asserts Pearson shows that it is old and well known to separately provide an individual vacuum generator (44) for each area of vacuum desired. The Office goes on to state that the use of multiple generators allows a vacuum force to be selectively created at desired locations along the tool to efficiently handle workpieces of varying shapes and sizes. Accordingly, the Office asserts that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide a separate vacuum generator for each vacuum port (14) of Lovegrove's tool as taught by Pearson so that only those ports needed for engaging certain sized articles could be actuated, thereby saving energy. For at least the following reasons, Applicants respectfully traverse this rejection.

As an initial matter, Applicants respectfully submit that the field of art of the Lovegrove reference is non-analogous to the field of art of the claimed invention, and therefore, does not constitute prior art. A reference is analogous if it is "in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned." *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

Applicants respectfully submit that the Lovegrove reference and Applicants' invention are not within the same field of endeavor. The invention described and claimed in Lovegrove is directed to "improvements in vacuum film holders...and is designed primarily for use in cameras employed in the graphic arts for holding sensitized photographic materials, films, glass plates, paper or thin metal sheets in the perfectly flat focal plane of the camera lens." Col. 1, lines 1-9. On the other hand, Applicants' invention is directed to a material handling tool for simultaneously handling a multitude of workpieces, such as, for example containers for consumer goods. (See, for example, Paragraph [0002]). Accordingly, Applicants respectfully submit that one of ordinary skill in the art of Applicants' invention would not look to the field of art of film holders for cameras in designing a tool for handling multiple workpieces such as containers for consumer goods for at least the reasons that the problems attendant in each field of art are substantially different (*i.e.*, weight, size, number of workpieces, etc.). Accordingly, Applicants respectfully submit that the respective fields of endeavor of the Lovegrove reference and Applicants' invention are substantially different from each other so as to constitute non-analogous art.

Applicants further submit that the second prong of the test set forth above for constituting analogous art is likewise met since the Lovegrove reference is not reasonably pertinent to the particular problem with which Applicants were concerned. Applicants were concerned with creating a vacuum tool that could be used with multiple workpieces and that would prevent failure or impairment of the entire system upon the failure or malfunction of a single vacuum generator. It cannot be said that Lovegrove is concerned with these particular problems since Lovegrove was directed to film holder that held a single "workpiece", not multiple workpieces; and because Lovegrove makes no mention of the problem associated with the failure of a vacuum generator. Accordingly, Applicants respectfully submit that because the Lovegrove reference is not reasonably

pertinent to the particular problem with which Applicants were concerned, this reference constitutes non-analogous art.

Notwithstanding the above, if it is determined that the Lovegrove reference is, in fact, analogous, Applicants respectfully submit the following.

“Patent examiners carry the responsibility of making sure that the standard of patentability enunciated by the Supreme Court and by the Congress is applied in each and every case.” MPEP § 2141 (emphasis in original).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP § 2143. Applicants respectfully submit that there is no suggestion or motivation to make the stated combination, and therefore, the combination, and thus the rejection bases thereon, is improper.

As set forth above, in order to combine two or more references or to modify one reference with the teachings of another, there must be some suggestion or motivation to do so. In the present case, the Office asserts that one of ordinary skill in the art would have been motivated to combine the teachings of the Lovegrove and Pearson references “so that only those ports needed for engaging certain sized articles could be actuated thereby saving energy.” Accordingly, the motivation the Office provides in support of the aforementioned combination is energy savings. For at least the following reasons, Applicants respectfully submit that this motivation is improper.

The Lovegrove reference describes a vacuum holder for film that includes a front plate 12 having a plurality of channels 14 formed therein. Channels 14 are configured such that vacuum/suction can be applied to one or more of the channels 14 in order to hold in place a piece of film covering the corresponding channels 14 to which vacuum or suction is applied. (See, for example, Col. 2, line 44 through Col. 3, line 6). The Lovegrove reference also describes a dial 38 that is operative to selectively control the supply of vacuum/suction to channels 14 such that none, some or all of the channels 14

can be supplied with vacuum/suction, depending on the size of the film being used. For example, column 3, lines 34-42 provides:

I also provide means movably mounted on the rear surface of said back plate, such as the dial 38 shown, and having the slot 40 in the front surface thereof of a length corresponding to the distance from the leading hole 24a to the end hold 24f of said aligned holes in said back plate, movable to successively uncover said holes to apply suction cumulatively to said respective channels on movement thereof. (emphasis added).

Similarly, column 4, lines 28-39 provides:

The slot 40 [of dial 38] is preferably made of arcuate formation...of a length corresponding to the arcuate distance 42 of the outermost gasket slot 22a and corresponding holes 24f-24a and channels 14f-14a to successively uncover said holes in synchronism with their respective indicia to successively apply suction cumulatively to said respective channels depending on the size of film employed. (emphasis added).

Lastly, column 5, lines 35-45 provides:

The operation of my invention is apparent from the above description. The operator selects the standard size film 19 required, sets the dial valve 38 by rotating it to the desired position indicated by the indicia 48 to allow vacuum in the required number of channels 14a-14f successively through the outer channel adjacent the film on the front plate over the corresponding area marked by the indicia 48, starts the vacuum pump, exposes the film, turns off the vacuum and removes the film. (emphasis added).

Accordingly, the Lovegrove reference provides a means for selectively providing vacuum/suction to only those channels 14 that are required to hold the particular sized film (i.e., the channels that are not covered by the piece of film are not provided vacuum/suction since they are not needed to hold that particular size of film in place). Applicants respectfully submit that this serves to save energy since only those channels that are needed to hold the film in place are provided vacuum/suction. Thus, the motivation cited by the Office – saving energy by actuating only those ports needed for engaging certain sized articles - is already present in the Lovegrove reference. Applicants respectfully submit that since the functionality that allows for the cited motivation already exists in the Lovegrove reference, one of ordinary skill in the art would not be motivated to combine the multiple vacuum generators taught in the Pearson reference to provide the same functionality or advantage. In other words, the motivation provided by the office – saving energy by actuating only those ports needed for engaging certain sized article – is

really no motivation at all since that advantage is already achieved in the Lovegrove reference, albeit in a different manner than the Pearson reference, and making the suggested modification would provide no further benefit.

Accordingly, Applicants respectfully submit that in light of the above, the motivation cited by the Office is improper, thereby also rendering the combination of the Lovegrove and Pearson references improper. Therefore, Applicants respectfully submit that the rejection of claims 1-7 has been traversed, and respectfully request that it be reconsidered and withdrawn.

#### **IV. REJECTION OF CLAIM 5 UNDER 35 U.S.C. § 103(a)**

Claim 5 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Lovegrove in view of Pearson as applied to claims 1-4, 6 and 7 above, and further in view of U.S. Patent No. 3,933,388 issued to Conboy. For at least the following reasons, Applicants respectfully traverse this rejection.

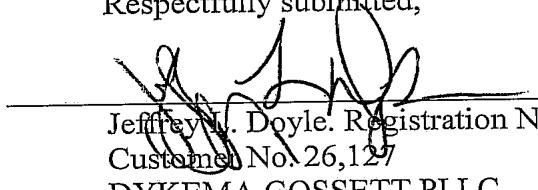
Applicants respectfully submit that claim 5 depends from base claim 1, and therefore, includes each and every limitation thereof. Accordingly, for at least the reasons set forth above relating to the allowability of claim 1, Applicants respectfully submit that claim 5 is likewise allowable. Therefore, Applicants respectfully request that the rejection of this claim be reconsidered and withdrawn.

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**V. CONCLUSION**

Applicants respectfully submit that in light of the foregoing, claims 1-24 are in condition for allowance and hereby respectfully request a Notice of Allowance of the same. If the Examiner has any further questions regarding this matter, please contact Applicants' undersigned attorney.

Respectfully submitted,

  
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